



1733

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

NAKAJIMA et al.

Serial No.: 10/084,266

Filed: February 25, 2002

Atty. File No.: 3688KG-1

For: "BONDING APPARATUS, BONDING  
METHOD AND THE COMPOSITION)  
BONDED THEREBY"

) Group Art Unit: 1733

) Examiner: Goff II, John L.

) RESPONSE TO  
) RESTRICTION REQUIREMENT

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SHERIDAN ROSS P.C.

BY:

*Christine Jaquet*

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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Dear Sir:

This reply to Restriction Requirement is submitted in response to the Examiner's Action dated February 3, 2004 (Paper No. 5), in connection with the above-identified patent application.

Although no fees are believed due in connection with the filing of this paper, please charge any fees deemed necessary to Deposit Account No. 19-1970.

In the Action dated February 3, 2004, a requirement was imposed that one of three identified inventions be elected for immediate prosecution. In particular, the Examiner identified the following groups of claims:

Group I (Claims 1-11 and 24-26) drawn to a bonding method;

Group II (Claims 12-19 and 27-28) drawn to a bonding apparatus; and

Group III (Claims 20-23) drawn to a composition/product.

The restriction requirement is hereby respectfully traversed. Accordingly, reconsideration and withdrawal of the restriction requirement are requested. Applicants provisionally elect to prosecute Claims 20-23 (Group III) should the restriction requirement be made final.

Furthermore, Applicants note that Claim 20 is a linking claim with respect to the claims of Groups I and II. Therefore, the restriction requirement with respect to the claims of Groups I and II should be withdrawn and these claims should be allowed if the restriction requirement is not immediately withdrawn and Claim 20 is allowed.

In the Office Action, the Examiner found that the invention set forth in the claims of Group I is related to the invention set forth in the claims of Group II as process and apparatus for its practice. Furthermore, the Examiner found that the apparatus as claimed can be used to practice another and materially different process such as bonding using adhesives other than hot melts. However, Applicant notes that the bonding apparatus as claimed recites a hot melt adhesive (see, *e.g.*, Claim 12, lines 4 and 7). Accordingly, reconsideration and withdrawal of the restriction between Groups I and II is respectfully requested.

The Office Action also finds that the invention set forth in the claims of Group I is distinct from the invention set forth in the claims of Group III. In particular, the Examiner finds that the process set forth in the claims of Group I can be used to make a product that is materially different from the composition/product set forth in the claims of Group III. More specifically, the Examiner finds that the claimed process could be used to make a product having through holes or one that is not hardened in a compressed state. In addition, the Examiner finds that the product as claimed can be made by a materially different process such as one where cooling occurs without the additional application of pressure. However, Applicants note that the

composition/product of Claims 20-23 does not require the absence of through holes in all of the recited members. With respect to making the product of Claims 20-23 by a materially different process, Applicants note that both sets of claims are related, and that the claims can be searched and examined without serious burden. Accordingly, reconsideration and withdrawal of the restriction between Groups I and III is respectfully requested.

Finally, the Office Action finds that the invention of Group II (Claims 12-19) is related to the invention of Group III (Claims 20-23) as apparatus and product made. In particular, the Office Action finds that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus as claimed can be used to make a different product such as one comprising adhesives other than hot melts. The Office Action further finds that the product can be made by a materially different apparatus such as one with a single heating/cooling section or one that does not apply pressure during cooling. Applicants note that the members operated on by the bonding apparatus recited by the claims of Group II correspond to the members recited by the composition or product recited by the claims of Group III. Furthermore, Applicants note that the search and examination of both the claims of Group II and the claims of Group III can be made without serious burden. Accordingly, the invention of Group II (Claims 12-19) and the invention of Group III (Claims 20-23) should not be restricted to separate applications and reconsideration and withdrawal of the restriction requirement as to Groups II and III are respectfully requested.

Even if, after consideration of the present Response to Restriction Requirement, a finding that the present application includes claims directed to independent or distinct inventions, each of the claims now pending in this application should be examined without restriction being

imposed. In particular, search and examination of the entire application can be made without serious burden. Accordingly, with respect to the present application, restriction would therefore be improper.

The Office Action states that the inventions identified in the pending claims are distinct because they can be separately classified and because the search required for any one of the identified groups is not required for any one of the other identified groups. However, as set forth more fully above, an adequate showing that the inventions identified by the Examiner are distinct has not been made.

Search and examination of the entire application can be made without serious burden. Accordingly, even if a finding that the application includes claims directed to independent or distinct inventions is made, the entire application should be examined on the merits. In particular, Applicant's note that a showing that search and examination of the entire application would result in a serious burden on the Examiner has not been made.

In view of the foregoing amendments and remarks, reconsideration and withdrawal of the Examiner's restriction requirement are respectfully requested. The Examiner is invited to contact the undersigned by telephone if doing so would expedite the resolution of this case.

Respectfully submitted,

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